

REMARKS

Claims 1-5, and 7-15 are pending in this application. At the outset, Applicants wish to thank the Examiner for indicating that claim 5 would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. Applicants respectfully submit that this was done in the previously filed Response, so that claim 5 stands in condition for allowance.

By this Amendment, claim 1 has been amended to more particularly point out and distinctly claim the external electron donor, support for which can be found at page 11, lines 3-8. Claim 3 has been amended to be dependent upon claim 1. Claims 16-18 are new, support for which can be found at page 11, lines 8-9. Claim 15 has been canceled without prejudice or disclaimer. Entry and consideration of this Amendment is earnestly requested in that no new matter has been introduced.

Claim Rejections

Rejections Under 35 U.S.C. § 103

A. Response to rejection of claims 1-4 and 6-15 under 35 U.S.C. §103(a) as being unpatentable over Chiba in view of Korvenoja et al.

In response to the rejection of claims 1-4 and 6-14 under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent JP 63075009 of Chiba (“Chiba”) in view of U.S. Patent No. 5,204,303 of Korvenoja et al. (“Korvenoja”), Applicants respectfully submit that a *prima facie* case of Obviousness has not been made out, and traverse the Rejection.

The U.S. Supreme Court in *Graham v. John Deere Co.*, 148 U.S.P.Q. 459 (1966) held that non-obviousness was determined under §103 by (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the art; and, (4) inquiring as to any objective evidence of non-obviousness. Accordingly, for the Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. See MPEP §2143. Finally, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. (BNA) 580 (C.C.P.A. 1974).

First, with respect to the currently pending claims, as the Examiner has acknowledged, Chiba does not teach the claimed external electron donor:

As correctly indicated by Applicants in the Remarks, Chiba only teaches the use of a glycol external electron donor and expressly teaches away any other fresh external electron donors such as those disclosed in claim 5. (Office Action, page 3, lines 17-19, emphasis added)

The currently recited claims recite that the external electron donor is selected from aliphatic ethers, esters and alkoxysilanes.

Second, as has also been acknowledged by the Examiner, Chiba does not expressly teach (i) conducting the polymerization in a gas phase polymerization; and (ii) internal electron donors besides polysiloxane. Applicants respectfully submit that Korvenoja does not remedy the deficiencies of Chiba, because the only gas-phase polymerization illustrated in Korvenoja is a one-step polymerization without use of comonomer. In fact, Korvenoja actually teaches away from the present claims inasmuch as it's procatalyst is useful for the "the preparation of ethylene having a narrow molecular weight distribution;" (col. 2, lines 58-61, emphasis added) whereas, the ethylene polymers described in the claimed process have a broad molecular weight distribution (page 15, lines 2-3). Similarly, Korvenoja teaches away from combination with Chiba, since Chiba criticizes narrow molecular weight material:

When polyethylene with a **narrow molecular weight** is subjected to hollow molding, the extrusion pressure tends to increase excessively during molding; the molding **becomes difficult** or **significant defects** occur in the product appearance due to formation of strands or pits or melt fracture. (page 4, lines 9-11, emphasis added)

Therefore, the references cannot be combined since it is improper under both Federal Circuit teaching and the MPEP to combine references where the references teach away from their combination (MPEP 2145 XD2, citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). In any event, the modifications of Chiba proposed by the Examiner do not

demonstrate a reasonable expectation of success since it "does not present a finite (and small in the context of the art) number of options easily traversed to show obviousness." *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008). Therefore, Applicants respectfully submit that a *prima facie* case of Obviousness has not been made out, and request that the Examiner reconsider and withdraw the rejection.

Applicants respectfully request that a timely Notice of Allowance be issued in this case. Should the Examiner have questions or comments regarding this application or this Amendment, Applicants' attorney would welcome the opportunity to discuss the case with the Examiner.

The Commissioner is hereby authorized to charge U.S. PTO Deposit Account 08-2336 in the amount of any fee required for consideration of this Amendment.

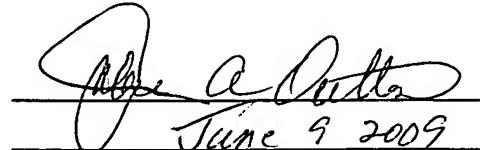
This is intended to be a complete response to the Office Action mailed March 18, 2009.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with sufficient postage thereon with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 9, 2009.



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June 9 2009

Date of Signature

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